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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,015	10/10/2001	Nicholas V. Nechitailo	A7909	5104

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EXAMINER

KIM, ELLEN E

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,015

Applicant(s)

NECHITAILO ET AL.

Examiner

Ellen E Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-33 and 61-83 is/are allowed.
- 6) ☒ Claim(s) 1-22 and 34-59 is/are rejected.
- 7) ☐ Claim(s) 23 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether “said pad” is “a buffer pad” in claim 1 [or claim 34] or “a pad” in claim 8 [or claim 43].

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 5-8, 12, 13, 15-20, 34-36, 40-43, 45, 47, 48, 50, 51, 54-57, and 59 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heinzer [USPAT 4,752,043].**

Heinzer discloses a method of and apparatus for winding a precision optical fiber coil comprising placing a buffer pad [base layer 2, column 2, lines 47-53], winding optical fiber onto the buffer pad, and functionally changing the draw tension [column 4, lines 19-26].

In re claim 5, Heinzer teaches at column 6, lines 5-27 that reduced speed of the spool would increase the tension of the optical fiber. Therefore, it is clear that the angular speed is changing.

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In re claim 8, Heinzer teaches at column 3, lines 43-58 that an adhesive layer [a pad] is applied during the progress.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 4, 9-11, 14, 21, 37, 39, 44, 46, 49, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinzer.**

Heinzer discloses every aspect of claimed invention except for the buffer pad or a pad having a Young's modulus lower than that of the material [optical fiber].

It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify to include the buffer pad or a pad having a Young's modulus lower than that of the material [optical fiber], since it has been held to be within the general skill

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of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In re claims 39, and 53, Heinzer discloses every aspect of claimed invention except for the length of the buffer tube which is less than 10 km. It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify the device to have a length of the buffer tube which is less than 10 km because practically any length of the tube can be utilized as desired.

**Claims 38 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinzer as applied to claim 34 above, and further in view of Christian et al [USPAT 5,211,789].**

Heinzer discloses every aspect of claimed invention except for the spool having a diameter is larger than 100 mm. Christian et al disclose an optical cable composite material bobbin having a diameter larger than 100 mm [column 3, line 63]. It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify Heinzer's device to include the spool having a diameter is larger than 100 mm as shown in Christian et al's reference for the purpose of reducing separation-type failures during storage [see column 2, lines 26-32].

***Allowable Subject Matter***

Claim 23-33, 60, and 61-83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose or suggest a method of winding a material on a spool comprising all the specific elements with the specific combination including winding the material onto a second spool while removing the pad from the winding as set forth in claims 23-75; and including measuring EFL and re-spooling the buffer tube onto a second spool to correct the EFL error as set forth in claims 76-83.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Further references of interest are cited on Form PLO-892, which is attachment to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen Kim whose telephone number is (703) 308-4946. The examiner can normally be reached on Monday and Thursday.

Ellen E. Kim



Primary Examiner

August 7, 2003/EK